

## REMARKS

Applicants acknowledge receipt of an Office Action dated March 30, 2009. Claims 1, 2, 5, and 9-17 are currently pending and under consideration. Applicants respectfully request reconsideration of the present application in view of the reasons that follow.

### **I. Allowable Subject Matter**

Applicants acknowledge, with appreciation, the Office's indication, on page 15 of the Office Action, that claims 2 and 16 would be allowable if rewritten in independent form.

### **II. Rejection of the Claims Under 35 U.S.C. § 102**

On pages 2-4 of the Office Action, the Office has maintained its rejection of claims 1, 5, 9-11, 15 and 17 under 35 U.S.C. § 102(e) as allegedly being anticipated by Corbett *et al.*, Pub. No. US 2005/0245504 ("Corbett"), Rogers *et al.*, Pub. No. US 2005/0107425 ("Rogers"), and Groppi *et al.*, Pub. No. US 2006/0019984 ("Groppi"). As discussed in Applicants' previously filed response, for each of these references, the Office cites the same two specific isoquinoline-substituted bicyclo compounds to support of the rejection: N-(3R)-1-azabicyclo[2.2.2]oct-3-yl-3-isoquinoline-carboxamide and its methyl derivative N-(3R)-1-azabicyclo[2.2.2]oct-3-yl-6-methyl-3-isoquinolinecarboxamide. Applicants acknowledge the PTO's comments regarding the relative number of pages in each reference and it's corresponding provisional application but submit that simply counting pages does not establish that the provisional application contains the disclosure relied upon by the PTO.

Applicants submit that claims 1, 5, 9-11, 15 and 17 are not anticipated by Corbett, Rogers, or Groppi because none of these three references has a 35 U.S.C. § 102(e) critical reference date that is prior to Applicants' priority date of May 12, 2003 for the purposes of this rejection. Thus, these references cannot be used as prior art against Applicants' claims.

The 35 U.S.C. § 102(e) critical reference date of a U.S. patent or patent publication is the filing date of the provisional application *if* the provisional application properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. § 112, first paragraph. See Manual of Patent Examining Procedure (MPEP), Eighth Ed., Section 2136.03, III, at page 2100-94 (August 2007).

The provisional application relied upon by Corbett, U.S. 60/432,527, discloses a broad genus of compounds and some specific compounds, but fails to disclose either of the two compounds cited by the Examiner, N-(3R)-1-azabicyclo[2.2.2]oct-3-yl-3-isoquinoline-carboxamide and N-(3R)-1-azabicyclo[2.2.2]oct-3-yl-6-methyl-3-isoquinolinecarboxamide. Each of these specific compounds is first disclosed in the subsequent non-provisional application, Appl. No. 10/731,565, which was filed on December 9, 2003. The effective 35 U.S.C. § 102(e) date for Corbett for the purposes of the rejection is thus the filing date of the nonprovisional application, December 9, 2003, which is *after* the May 12, 2003 filing date of Applicants' priority GB Appl. No. 0310867.7. Corbett cannot be used as prior art against Applicants' claims.

The same is true for both Rogers and Groppi. The provisional application relied upon by Rogers, U.S. 60/432,586, also discloses a broad genus of compounds, but fails to disclose either of the two specific compounds cited by the Office. Each compound is first disclosed in the subsequent non-provisional application, Appl. No. 10/731,402, which was filed on December 9, 2003, giving Rogers an effective 35 U.S.C. § 102(e) date of December 9, 2003, which is *after* Applicants' May 12, 2003 priority date. Rogers thus also cannot be used as prior art against Applicants' claims.

Similarly, Groppi cannot be used as prior art against the claims, because the compounds cited in the rejection are first disclosed in the nonprovisional application, Appl. No. 10/761,914, filed on January 21, 2004, rather than in priority provisional application, thus giving Groppi an effective 35 U.S.C. § 102(e) date of January 21, 2004, which is *after* Applicants' May 12, 2003 priority date.

Thus, Corbett, Rogers, and Groppi are not available as prior art because the 35 U.S.C. § 102(e) critical reference date for each falls *after* Applicants' priority date of May 12, 2003. Accordingly, claims 1, 5, 9-11, 15 and 17 cannot be anticipated by any of these references and are thus novel.

Applicant believes that the rejection of claims 1, 5, 9-11, 15 and 17 under 35 U.S.C. § 102 has been overcome or rendered moot and requests that this rejection be withdrawn.

**III. Rejection of the Claims Under 35 U.S.C. § 103 – Corbett, Rogers, Groppi**

Claims 1, 5, 9-15, and 17 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable alternatively over Corbett, Rogers, and Groppi. (Office Action, at pages 5-9). Applicant respectfully traverses.

As discussed above, the Office is attempting to rely upon disclosure in Corbett, Rogers, and Groppi which is not available as prior art. Accordingly, Applicants submit that these rejections are improper and ought to be withdrawn. Reconsideration and withdrawal of each of these rejections is respectfully requested.

**IV. Rejection of the Claims Under 35 U.S.C. § 103 - Jacobsen**

Claims 1, 5, 9-15, and 17 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Jacobsen *et al.*, U.S. Pat. No. 7,001,900 (“Jacobsen”). (Office Action, at page 16, lines 9-10.). Applicant respectfully traverses.

With this response, Applicants are submitting a Declaration Under 37 C.F.R. § 1.131 to antedate and remove Jacobsen. In view of this submission, Applicants submit that Jacobsen is no longer available as prior art and that this rejection is now moot. Reconsideration and withdrawal of the outstanding rejection based upon Jacobsen is respectfully requested.

**CONCLUSION**

Based on the foregoing remarks, Applicant respectfully requests that the Examiner reconsider all rejections and objections and that they be withdrawn. Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated,

otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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By P.D.S.

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